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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,331	04/01/2004	Ray C. Minor	P69605US0	5342
136	7590	09/12/2006	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			BURCH, MELODY M	
			ART UNIT	PAPER NUMBER
			3683	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/814,331	Applicant(s) MINOR, RAY C.	
	Examiner Melody M. Burch	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-50 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-43 is/are allowed.
- 6) ☒ Claim(s) 44-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 44-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant failed to provide support in the original specification for the limitation of the weight receiving chambers solely being occupied by spherical ball damping weights recited in claim 44. Examiner notes that nothing in the disclosure suggested that the device was in a vacuum, therefore, at least air would also occupy the chambers. Examiner also rejected the limitation of "solely ambient air and a spherical ball damping weight" occupying the chamber because the original specification did not provide such limitations on the content found in the chambers. The remaining claims are rejected due to their dependency from claim 44.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 44, 45, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4433592 to Tatsumi et al.

Re: claims 44, 45, and 50. Tatsumi et al. show in figures 6 and 7 a vibration damping device mountable on a non-rotatable vertical pole (Examiner notes that although the pole of Tatsumi rotates it is non-rotatable or capable of not rotating when it is in an off state, as broadly recited) for damping wind induced first harmonic mode vibrations comprising a housing 18 mountable on such a pole as shown in figure 4 and including an annular horizontally aligned array of weight receiving chambers shown in figure 7 solely occupied by a spherical ball damping weight 62 and wherein the housing is shaped and dimensioned to encircle and facingly engage such a pole to effect mounting of the device on the pole as shown in figure 4, and the horizontally aligned weight receiving chambers are separated by planar panels 64,66 preventing movement of the spherical ball damping weights from one weight receiving chamber to an adjacent weight receiving chamber.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsumi et al.

Re: claims 46 and 47. Tatsumi et al. are silent with regards to the specific material of the balls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the balls to have been metal or specifically lead since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatsumi et al. in view of US Patent 4655317 to Kolya et al.

Re: claim 48. Tatsumi et al., as modified, describe the invention substantially as set forth above, including the limitation of the damping weights being spherical balls, but are silent as to the balls being metal and plastic coated.

Kolya et al. teach in col. 3 line 68 - col. 4 line 5 the limitation of a spherical body being coated with plastic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the spherical balls of Tatsumi et al., as modified, to have been coated with plastic, as taught by Kolya et al., in order to provide a means of insulating sound.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the balls to have been metal since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Re: claims 40 and 49. Hannah et al., as modified, lack the limitation of the damping weights being metal or that they are coated with polyurethane.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the material of the balls to have been metal since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Kolya et al. teach in col. 3 line 68 - col. 4 line 5 the limitation of a spherical body being coated with polyurethane.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the spherical balls of Hannah et al., as modified, to have been coated with polyurethane, as taught by Kolya et al., in order to provide a means of insulating sound.

Allowable Subject Matter

8. Claims 33-43 are allowed. In light of the rule that Applicant is allowed to be his own lexicographer, Examiner notes that claim 33 defines over the Hannah reference since the pole of Hannah is not vertical (in the direction of earth gravitational force, radial toward the center of the earth and generally orthogonal to the earth surface) as defined by Applicant. See pg. 9 of the Remarks. The remaining claims are allowable due to their dependence from claim 33.

Response to Arguments

9. Applicant's arguments filed 6/27/06 have been fully considered but they are not persuasive. Examiner further notes that the declaration by Dr. J.A. Puckett has been thoroughly considered.

Applicant and Dr. Puckett argue that Tatsumi is non-analogous art since it is directed to balancing instead of damping. Examiner notes that in col. 1 lines 44-50 of Hannah, the reference describes the Beynet device which comprises at least one race in which are placed balls or rollers that are free to move to counteract imbalance forces. The described Beynet device is specifically called a vibration damping assembly in lines 44-45 of Hannah. Since the device of Tatsumi includes a race in which balls are free to move to counteract imbalance forces, Examiner maintains that it is too a vibration damping assembly. Accordingly, the Tatsumi reference is not non-analogous.

With regards to the use of *In re Leshin* for the rejection of the material-specific claims, Applicant argues that there is no prior art which makes the use of metal or lead balls or polyurethane covered balls obvious or successful. Examiner notes that in *Leshin* there was no reference used to teach the specific plastic used by Applicant. The plastics that the applicant used were known and, thus, the mere selection of known materials that were suitable for the intended use was simply held to be obvious. Examiner maintains that metal/lead was known material at the time of the invention so the mere selection of metal/lead from other known materials to satisfy a particular intended purpose is also obvious. Despite Applicant's argument otherwise, the cited sections of the cases pointed out by Applicant on pg. 34 of the Remarks suggest more

that no reference is required for the rejection than that it is required. Also section 2144 of the MPEP states that an examiner may rely solely on case law if Applicant has not demonstrated the criticality of a specific limitation. Examiner maintains that no criticality was provided for the specific limitation of metal or lead. The rejection of the claims reciting polyurethane coating were rejected using a reference. Accordingly, the argument does not apply to the rejection of the claims reciting the polyurethane coating.

In response to applicant's argument that Koyla is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Koyla is reasonably pertinent to the particular problem with which the applicant was concerned. Applicant is concerned with suppressing or damping vibration and Koyla was concerned with suppressing or damping noise – a form of vibration. Additionally, the fact that Koyla teaches a partial coating does not preclude its use for rejecting a claim that simply recites the presence of a “coating.” Accordingly, Examiner has maintained the use of Tatsumi and Koyla in the rejection of the claims.

10. Applicant's arguments, see pg. 15-16, filed 6/27/06, with respect to the rejection(s) of the claim(s) under 35 USC 1.03 with Hannah in view of Tatsumi have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tatsumi. Examiner agrees that adding the panels as suggested by Examiner would

teach away from the free movement of the balls in the race. The rejections using the Hannah reference have also been withdrawn in light of Applicant's definition of "vertical" which limits a vertical orientation to be in "the direction of earth gravitational force, radial toward the center of the earth and generally orthogonal to the earth surface" as defined on pg. 9 of the Remarks.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb
September 7, 2006

Melody M. Burch
Melody M. Burch
Primary Examiner
Art Unit 3683

9/7/06